

REMARKS

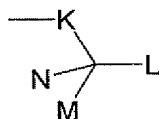
The Rejections Under 35 USC § 112

The second occurrence of each structure provided in the Office Action has been removed from the claims.

Applicants respectfully disagree with the allegation regarding claim 20 for reasons detailed below. The structures are identified as first, second, ... going from top right to left then proceeding to the next row of structures, again going from right to left.

The first structure in claim 20 has antecedent basis in claim 19 as follows:

R^{*1} is a chiral radical of the following formula

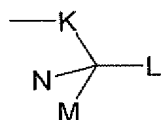


in which

K is alkylene having 1 C atoms, wherein one -CH₂- group is replaced by -O-,
two of L, M and N, each, independently of one another, but differently from one another
alkyl having 1 to 11 C atoms, and
one of L, M and N (which is Q in the formula in claim 20) is hydrogen or halogen.

The second structure in claim 20 has antecedent basis in claim 19 as follows:

R^{*1} is a chiral radical of the following formula

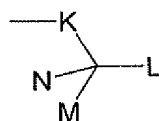


in which

K is alkylene having 1 C atoms, wherein one -CH₂- group is replaced by -O-,
one of L, M and N is alkyl having 1 to 11 C atoms,
one of L, M and N is alkenyl having 2 C atoms, and
one of L, M and N (which is Q in the formula in claim 20) is hydrogen or halogen.

The third structure in claim 20 has antecedent basis in claim 19 as follows:

R^{*1} is a chiral radical of the following formula



in which

K is alkylene having 1 C atoms, wherein one -CH₂- group is replaced by -O-,

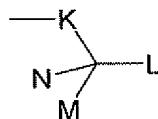
one of L, M and N is alkyl having 1 to 11 C atoms,

one of L, M and N is alkynyl having 2 C atoms, and

one of L, M and N (which is Q in the formula in claim 20) is hydrogen or halogen.

The fourth structure in claim 20 has antecedent basis in claim 19 as follows:

R*¹ is a chiral radical of the following formula



in which

K is alkylene having 1 C atoms, wherein one -CH₂- group is replaced by -O-,

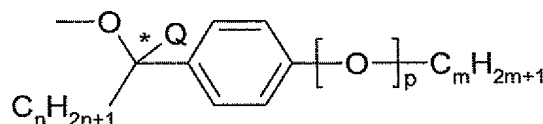
one of L, M and N is alkyl having 1 to 11 C atoms,

one of L, M and N is aryl (which in this case happens to be phenyl), and

one of L, M and N (which is Q in the formula in claim 20) is hydrogen or halogen.

The fifth structure in claim 20 has antecedent basis in claim 19 as follows:

R*¹ is a group

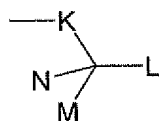


where all the substituents are defined as in claim 19.

The sixth structure in claim 20 was identical with the third structure and has been deleted.

The seventh structure in claim 20 has antecedent basis in claim 19 as follows:

R*¹ is a chiral radical of the following formula



in which

K is alkylene having 2 C atoms, wherein one -CH₂- group is replaced by -O-,

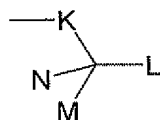
one of L, M and N is alkyl having 1 to 11 C atoms,

one of L, M and N is alkenyl having 2 C atoms, and

one of L, M and N (which is Q in the formula in claim 20) is hydrogen or halogen.

The eighth structure in claim 20 has antecedent basis in claim 19 as follows:

R^{*1} is a chiral radical of the following formula



in which

K is alkylene having 2 C atoms, wherein one -CH₂- group is replaced by -O-, and another

-CH₂- group is replaced by -C=O-,

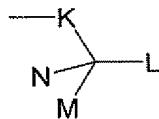
two of L, M and N, each, independently of one another, but differently from one another

alkyl having 1 to 11 C atoms, and

one of L, M and N (which is Q in the formula in claim 20) is hydrogen or halogen.

The ninth structure in claim 20 has antecedent basis in claim 19 as follows:

R^{*1} is a chiral radical of the following formula



in which

K is a single bond (that is when r is 0) or alkylene having 1 to 4 C atoms (when r is 1-4),

two of L, M and N, each, independently of one another, but differently from one another

alkyl having 1 to 11 C atoms, and

one of L, M and N (which is Q in the formula in claim 20) is hydrogen or halogen.

Reconsideration is respectfully and courteously solicited.

Withdrawn Claims

Withdrawn claims 8, 12 and 34 are method or process claims dependent on allowed or allowable claims. Applicants bring the attention of the Examiner to MPEP § 821.04, Rejoinder, and request that in accord with the mandate thereof these non-elected process and method claims be rejoined.

Withdrawn claims 10 and 35 recite products (electro-optical displays), which contain the products (a liquid-crystal medium comprising a compound of the elected claims), which elected claims are now even allowed or allowable, as combination-subcombination, i.e., the electro-optical displays are a combination of the subcombination (liquid-crystal compounds of the elected claims) and other components.

Since they are related as combination-subcombination, the standard for requiring restriction herein is not met.

To support a requirement for restriction between combination and subcombination inventions, **both two-way distinctness and reasons for insisting on restriction are necessary**, i.e., there would be a *>serious< search burden >if restriction were not required< as evidenced by separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

(A) **does not require the particulars of the subcombination** as claimed for patentability (to show novelty and unobviousness), **and**

(B) the subcombination can be shown to have utility either by itself or in another materially different combination.

(Emphasis added.) (M.P.E.P. §806.05(c))

It is submitted that at least the first requirement for two-way distinctness is not established herein. The combination does require the particulars of the subcombination. The products (electro-optical displays) of the withdrawn product claims all require the exact same products (compounds of the elected claims) of the same scope as the subcombination claims of the elected group. To this end, the combination claims are even dependent upon the subcombination-product claims and the subcombination-products are an essential distinguishing feature of the combination-products.

Additionally, there are no reasons supported by evidence provided for insisting on the necessity of the restriction. The Patent Office has not established that it would pose a serious search burden on the Examiner to search the group containing the combination claims. No further, or only a minimal, search would be necessary to allow the combination claims once the elected claims are allowed. If the elected products (compounds of the elected claims) themselves are patentable, products (electro-optical displays) comprising the same products (compounds of the elected claims) should be patentable as well for at least the reason that they contain a patentable compound.

It is respectfully submitted that the combination claims are improperly withdrawn. Accordingly, the restriction requirement should be withdrawn

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

Csaba Henter, Reg. No. 50,908
Attorney for Applicants

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1
2200 Clarendon Boulevard, Suite 1400
Arlington, VA 22201
Telephone: 703-243-6333
Facsimile: 703-243-6410
Attorney Docket No.:MERCK-2991

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